



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/014,297 01/27/98 BROWN

F LI30-001

021567 LMC1/0623
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EXAMINER

CHOI, K

ART UNIT

PAPER NUMBER

2763
DATE MAILED:

06/23/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action

Application No.

09/014,297

Examiner

Kyle J. Choi

Applicant(s)

BROWN, FRED A.

Art Unit

2763

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 30 May 2000 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either a timely filed amendment which places the application in condition for allowance or a Notice of Appeal. Alternatively, applicant may obtain further examination by timely filling a request for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d).

PERIOD FOR REPLY [check only a) or b)]

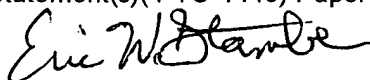
- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 707.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136 (a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked.

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search. (see NOTE below);
- (b) ☐ they raise the issue of new matter. (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

4. ☐ Applicant's reply has overcome the following rejection(s): _____.
5. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
6. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: 1-20.
- Claim(s) withdrawn from consideration: _____.
9. ☐ The proposed drawing correction filed on _____ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
11. ☐ Other: _____



ERIC W. STAMBER
PRIMARY EXAMINER

(see attached Office Action)

Art Unit: 2763

DETAILED ACTION

1. The following is an Advisory Office Action in response to communication received on May 30, 2000. The amendment proposes to cancel claims 1-20 and adds new claims 21-40. However, the amendment was NOT entered because of the following reasons.

Amendment does not simplify issues for appeal

2. Newly submitted claims 21-24, 27, 30, 34-37, 40 are not deemed to place the application in a better form for appeal by materially reducing or simplifying the issues for appeal. In particular, newly submitted independent claims 21 and 40 both recite the steps of (paraphrased):

- providing data of an existing power line;
- providing a first model of the power line with initial design parameters;
- analyzing the first model under increased operating conditions to identify violations of its operability; and
- providing a second model by altering the initial design parameters to provide a design having increased power handling capability.

a. Firstly, claims 21 and 40 now introduce §112, second paragraph issues because there is no nexus between the recited steps. In particular, the step of analyzing the first model for violations have no relationship to the last step of generating a second model. Even though the language seems to insinuate that the second model is generated by modifying the initial

Art Unit: 2763

parameters based on the analysis generated in the analyzing step, that is not what the claims recite. If indeed the second model is provided by modifying the initial parameters based on the analysis of the first model, then there is further \$112, second paragraph problems in that is it unclear why a second model would be generated if the first model passes the analyzing step without any violations. There is too much ambiguity in the claims due to vague and indefinite language between the recited steps.

b. Secondly, the last step in claim 21 is awkward. It seems the word --to-- is missing between "parameters" and "provide" in line 13.

c. Thirdly, claim 40 recites an apparatus (i.e., computer) but the rest of the recitation includes steps of a method. Applicant is reminded that functionality (i.e., the recited steps) does not further limit an apparatus (i.e., the computer). Indeed, claims directed to an apparatus (i.e., a computer in this case) must be distinguished from the prior art in terms of structure rather than by function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device *is*, not what a device *does*." (emphasis in original) *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir.

Art Unit: 2763

1990). Moreover, a claim containing a recitation with respect to the manner in which a claimed apparatus (i.e., a computer in the present case) is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). See M.P.E.P. §2114. This means that any prior art "computer" will meet the structural limitations of claim 40.

d. Lastly, the above-identified claims still fail to recite patentable subject matter over Thompson et al. (US Pat. No. 5,574,841) as applied to claims 1-20. In particular, the only distinguishable limitations recited in newly submitted claims over the currently pending claims 1-20 are the step of providing a "first model of the existing power line configured according to the initial design parameters" and the step of providing a "second model by altering the initial design parameter with a modified design parameters to provide increased power handling capabilities". As explained in the last Office Action (paper no. 12) in detail, the Thompson patent allows the user to survey already existing power lines and allows the engineer to model the already existing power line the disclosed design apparatus to change the type of conductor, for example,

Art Unit: 2763

on the already existing power line. By changing the type of conductor on a modeled power line automatically generates a "second model" by virtue of having changed a parameter that is different from the initial model. Hence, the above-identified claims are all anticipated by Thompson et al. for the reasons stated in the last Office Action.

For the reasons stated above, claims 21-24, 27, 30, 34-37, 40 not only fail to materially reduce the issues but rather increases the issues for appeal. Hence, these claims are not entered.

Amendment raises new issues

3. Newly submitted claims 25, 26, 28, 29, 31-33, 38-39 raises new issues that would require further consideration and/or search. In particular, none of the previous claims recited:

- static equilibrium states (cl. 25, 28, 38-39);
- analysis of insulators and stiffness of supports (cl. 26);
- checking for violations between adjacent spans (cl. 31);
- and
- checking for tension violations (cl. 32).

Conclusion

4. For the reasons stated above, the amendment of May 30, 2000 have NOT been entered. Additionally, the Information Disclosure Statement filed therewith was also NOT considered since it was filed after a final Office Action was issued without a 37 C.F.R. §1.97(e) statement, petition, or petition fee.

5. As discussed with Primary Examiner Eric Stamber during a telephonic interview with the applicant's representative of record, the finality of the last Office Action was proper since the Continued Prosecution Application request indicated that the request for reconsideration was the preliminary amendment.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle J. Choi whose telephone number is (703)306-5845. The examiner can normally be reached on Monday-Friday, 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin J Teska can be reached on (703)305-9704. The fax phone numbers for the organization where this application or proceeding is assigned are (703)308-1396 for regular communications and (703)308-1396 for After Final communications.

Art Unit: 2763

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 308-9051 (for formal communications intended for entry)

or:

(703) 308-1396 (informal or draft communications labeled "PROPOSED" or "DRAFT")

Hand delivered responses should be brought to Crystal Park 2, 2121 Crystal Drive, Arlington, VA., 6th floor receptionist.

KJC

June 19, 2000